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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,934	11/25/2003	Rita Bitzer	10537/171A	9401
26646	7590	05/16/2006	EXAMINER	
KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004			GREEN, ANTHONY J	
			ART UNIT	PAPER NUMBER
			1755	
DATE MAILED: 05/16/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/723,934

Applicant(s)

BITZER ET AL.

Examiner

Anthony J. Green

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-10,12-17,27 and 31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-10,12-17,27 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 05/01/06.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 14 April 2006 has been entered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 2-10, 12-17, 27 and 31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicant argues that the claims are enabled as one of ordinary skill in the art would know how to make and/or use the invention without undue experimentation and that the size of roughness, average port diameter and score marks was known. Further

applicant also argues that the claims have been amended to clarify that the composition is for a braking surface.

To these arguments the examiner respectfully disagrees. Applicant's arguments are without merit since the information concerning the grain size of the material has not been included in the present specification. It is not clear as to who one of ordinary skill in the art is supposed to be. Is applicant trying to say that the level of skill is one of ordinary skill in the braking art or in the lacquer art? The fact remains that this composition can be used in other venues besides braking systems as it is merely drawn to a corrosion protective lacquer (it is not limited to a composition specifically for protecting braking surfaces) and therefore the person of skill in the art other than the art of braking surfaces would require a great deal of experimentation to ascertain the grain size required. Applicant's arguments are based on unrecited comparisons. The specification provides no guidance as to the grain size of the protective substances used that are within the scope of the invention. **Applicant is claiming a composition by properties based on its ultimate intended use (as in braking systems)** which renders the claims not enabled as the exact grain size of the composition would depend on the average grain size of the particular braking system utilized and would require undue experimentation to determine the scope of the claim. One cannot determine what size is within the scope of the claim and therefore one cannot ascertain what grain size would infringe on the instant claim and accordingly an accurate comparison of the prior art with the instant claims cannot be performed. Applicant's amendment to the claim does not limit it specifically for use in braking systems. Again, it's use in braking

systems is an intended use and as such, it adds little or no patentable weight to the claim.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2-10, 12-17, 27 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the independent claims it is unclear as to the grain size encompassed by the phrase "substantially equal to at least one of a maximum roughness, an average pore diameter and an average size of score marks". Applicant argues that the claims are not indefinite as the size of roughness, average pore diameter and average score marks on a braking surface of a brake disk and brake drum was known to one of ordinary skill in the art at the time of the filing of the application.

To this argument the examiner respectfully disagrees. The claim is drawn to a composition and is not limited to a braking surface composition and therefore one cannot ascertain the size encompassed by the claims. Applicant should also refer to the comments found in the 112 1<sup>st</sup> paragraph rejection that appear above for a more detailed discussion.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

NOTE: The references utilized in the following rejections were previously cited in other office actions and therefore copies are not provided.

7. Claims 2-4, 10, 12-14, 17, 27 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by German Patent Specification No. DE 4314432.

The reference teaches, in the abstract, an anticorrosion lacquer for organic bonded friction linings such brake and clutch linings comprising phenolic resin, inorganic zinc compounds, optionally silicic acid and an adhesive. The amount of the zinc compounds is from 20 to 40%.

The instant claims are met by the reference. It is the position of the examiner that the inorganic zinc compound meets applicants protective substance that reacts with oxygen. Note page 2 of the reference, lines 46-47, which recite the types of inorganic zinc compounds utilized. With respect to claim 27 while the reference does not recite that the lacquer is non-tinted or tinted, it is the position of the examiner that it would have to be one or the other as lacquers are either clear or tinted absent evidence to the contrary. Furthermore it is believed that the presence of the zinc compound would tint the lacquer absent evidence showing otherwise. As for the grain size, it is the position of

the examiner that absent evidence showing otherwise the grain size of the reference meets the instantly claimed grain size especially since the composition of the reference is used for the same purpose. Thus the instant claims are met by the reference.

8. Claims 2-6, 8, 10, 12-16, 27 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Derwent Patent Abstract No. 2002-112318 (abstract of RU 2169164) and Derwent Patent Abstract No. 2001-474589 (abstract of RU 2169165).

The references teach, in the abstract, anticorrosion compositions comprising polyurethane lacquer, highly dispersed zinc powder, rheological additive, and organic solvent.

The instant claims are met by the references. While the references do not teach that the composition is for a braking surface it should be noted that the phrase "for a braking surface" is an intended utility or future use and as such adds little or no patentable weight to the claim. Ultimate intended utility does not make a composition patentable. See In re Pearson, 181 U.S.P.Q. 641. It is the position of the examiner that the zinc powder meets applicants protective substance that reacts with oxygen, thus claims 2-3, 10, 12-13, 17 and 31 are taught by the reference. The amount of the zinc compound is from 69.8-79.8 in RU 2169164 and 71.1-79.5 in RU 2169165 which meets instant claims 4-6 and 14-16. As for claim 8 the amounts of the organic solvents in the references appear to be in a relatively low proportion as compared to the other components thus claim 8 is met. With respect to claim 27 while the reference does not recite that the lacquer is non-tinted or tinted, it is the position of the examiner that it

Art Unit: 1755

would have to be one or the other as lacquers are either clear or tinted absent evidence to the contrary. Furthermore it is believed that the presence of the zinc powder would tint the lacquer absent evidence showing otherwise. As for the grain size, it is the position of the examiner that absent evidence showing otherwise the grain size of the reference meets the instantly claimed grain size. Thus the instant claims are met by the references.

9. Claims 2-3, 10, 12-13, 17, 27 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by European Patent Specification No. 683,213.

The reference teaches in the abstract, a protective lacquer to protect a mirror against corrosion comprising a film former, polyester resin, and zinc dust.

The instant claims are met by the reference. While the reference does not teach that the composition is for a braking surface it should be noted that the phrase "for a braking surface" is an intended utility or future use and as such adds little or no patentable weight to the claim. Ultimate intended utility does not make a composition patentable. See *In re Pearson*, 181 U.S.P.Q. 641. It is the position of the examiner that the zinc dust of the reference meets applicants protective substance that reacts with oxygen, thus meeting claims 1-3 and 11-13. With respect to claim 27 while the reference does not recite that the lacquer is clear or tinted, it is the position of the examiner that it would have to be one or the other as lacquers are either clear or tinted absent evidence to the contrary. Furthermore it is believed that the presence of the zinc compound would tint the lacquer absent evidence showing otherwise. As for the grain



size, it is the position of the examiner that absent evidence showing otherwise the grain size of the reference meets the instantly claimed grain size. Thus the instant claims are met by the reference.

10. Claims 2-6, 8-10, 12-17, 27 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by German Patent Specification No. DE 4341659.

The reference teaches, in the abstract, a corrosion resistant lacquer containing a binder, solvent, thinner, pigment and various additives. The pigment contains corrosion resistant powdered zinc alloys. The example found in the abstract teaches the amounts of the components.

The instant claims are met by the reference. While the reference does not teach that the composition is for a braking surface it should be noted that the phrase "for a braking surface" is an intended utility or future use and as such adds little or no patentable weight to the claim. Ultimate intended utility does not make a composition patentable. See *In re Pearson*, 181 U.S.P.Q. 641. It is the position of the examiner that the zinc alloys of the reference meets applicants protective substance that reacts with oxygen, thus meeting claims 2-3 and 12-13. As for claims 4-6 and 14-16 the amount of the zinc alloy present in the composition meets these claim limitations. As for claim 8 the amount of the solvents in the example appear to be in a relatively low proportion as compared to the other components such as the zinc alloy and resin. As for claim 9 the composition contains water. With respect to claim 27 since pigments are added it is believed that the lacquer would be tinted absent evidence to the contrary. As for the

grain size, it is the position of the examiner that absent evidence showing otherwise the grain size of the reference meets the instantly claimed grain size. Thus the instant claims are met by the reference.

11. Claims 2-6, 10, 12-17, 27 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by German Patent Specification No. DE 3018765.

The reference teaches, in the abstract, a corrosion protective powdered lacquer film composition comprising zinc dust and can contain mixtures of thermosetting binders and pigments such as aluminum powder.

The instant claims are met by the reference. While the reference does not teach that the composition is for a braking surface it should be noted that the phrase "for a braking surface" is an intended utility or future use and as such adds little or no patentable weight to the claim. Ultimate intended utility does not make a composition patentable. See *In re Pearson*, 181 U.S.P.Q. 641. It is the position of the examiner that the zinc dust of the reference and/or the aluminum powder meets applicants protective substance that reacts with oxygen, thus meeting claims 2-3 and 12-13. The amount of the zinc dust is from 60-90% thus meeting claims 4-6 and 14-16. With respect to claim 27 the reference teaches the addition of pigments and accordingly the lacquer would be tinted absent evidence to the contrary. As for the grain size, it is the position of the examiner that absent evidence showing otherwise the grain size of the reference meets the instantly claimed grain size. Thus the instant claims are met by the reference.

12. Claims 2-5, 8, 10, 12-15, 27 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Hestermann et al (US Patent No. 4,337,092).

The reference teaches, in the abstract, examples and the claims, a paint or lacquer composition comprising a corrosion inhibiting pigment and other additives such as solvents, binders etc. (see especially the examples).

The instant claims are met by the reference. While the reference does not teach that the composition is for a braking surface it should be noted that the phrase "for a braking surface" is an intended utility or future use and as such adds little or no patentable weight to the claim. Ultimate intended utility does not make a composition patentable. See In re Pearson, 181 U.S.P.Q. 641. It is the position of the examiner that the pigments of the reference meets applicants protective substance that reacts with oxygen, thus meeting claims 2-3 and 12-13. The amount of the pigments is from 10-60 volume% thus meeting claims 4-5 and 14-15. With respect to claim 27 the reference teaches the addition of pigments and accordingly the lacquer would be tinted absent evidence to the contrary. As for the grain size, it is the position of the examiner that absent evidence showing otherwise the grain size of the reference meets the instantly claimed grain size. Thus the instant claims are met by the reference.

13. Claims 2-3, 8-10, 12-13, 17, 27 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Schmidt et al (US Patent No. 4,321,175).

The reference teaches, in the examples, corrosion protective lacquer compositions, comprising titanium dioxide, iron oxide black pigment, mica, calcium carbonate and other components.

The instant claims are met by the reference. While the reference does not teach that the composition is for a braking surface it should be noted that the phrase "for a braking surface" is an intended utility or future use and as such adds little or no patentable weight to the claim. Ultimate intended utility does not make a composition patentable. See *In re Pearson*, 181 U.S.P.Q. 641. It is the position of the examiner that the pigments of the reference meets applicants protective substance that reacts with oxygen, thus meeting claims 2-3 and 12-13. As for claim 8 the amount of the solvent utilized in the examples appears to be in a relatively low proportion as compared to the other components. With respect to claim 9 the examples teach the addition of water and accordingly the lacquer could be considered to be water based absent evidence to the contrary. As for claim 27 the reference teaches the addition of a pigment and accordingly the lacquer would be tinted absent evidence to the contrary. As for the grain size, it is the position of the examiner that absent evidence showing otherwise the grain size of the reference meets the instantly claimed grain size. Thus the instant claims are met by the reference.

14. Claims 2-7, 10, 12-17, 27 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by European Patent Specification No. 976,795.

The reference teaches, in abstract, the examples and the claims, an antifriction coating comprising a lubricant, corrosion inhibitor and solvent. The composition may be used to treat brake rotors and drums (abstract).

The instant claims are met by the reference. It is the position of the examiner that the coating of the reference can broadly be considered to be a "lacquer" absent evidence to the contrary as one definition of the term "lacquer" is known in the art to represent "any of various clear or colored synthetic organic coatings that typically dry to form a film by evaporation of the solvent" (a copy of this definition was included in a previous office action). The corrosion inhibitor is selected from aluminum particles, zinc particles and a metal phosphate which meets the protective substance of instant claims 2-3 and 11-13. As for the amount of protective substance (instant claims 4-6 and 14-16) the claims recite that the amount ranges from 40 to 65% (with the solvent (i.e. claim 5 of the reference)) or 70-80% after curing (i.e. without the solvent (claim 9 of the reference)). As for claim 27 the examples teach the addition of pigments thus meeting this claim. As for the grain size, it is the position of the examiner that absent evidence showing otherwise the grain size of the reference meets the instantly claimed grain size especially since the composition of the reference is used for the same purpose. Thus the instant claims are met by the reference.

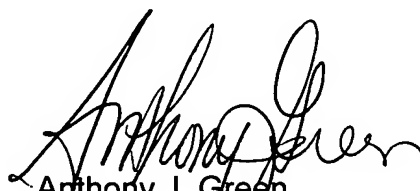
#### ***Information Disclosure Statement***

15. The references cited by the applicant have been reviewed by the examiner and are considered to be cumulative to or less relevant than the prior art references relied upon in the above rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony J. Green  
Primary Examiner  
Art Unit 1755

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May 12, 2006